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10/567,289	11/20/2006	Marcel Hendricus Maria Nienhuis	06-073	6760
20306 7590 08/27/2008 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER DARNER, CHRISTOPHER J				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/567,289

**Applicant(s)**

NIENHUIS ET AL.

**Examiner**

CHRISTOPHER J. DARNER

**Art Unit**

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-28 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 03 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Specification***

1. The abstract of the disclosure is objected to because the abstract should not be longer than 150 words. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

2. Regarding claims 8, 10, and 24, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 and 14-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palsson et al. (U.S. Patent # 7,121,058) as applied to claim 1 above, and further in view of Searer (U.S. Patent # 5,570,554).

With respect to claim 1, Palsson discloses the undercut of the groove (13) and the part of the tongue (11) protruding beyond the edge each have an at least partly chambered profile in Figure 10.

Palsson teaches the groove and the tongue each form profiles complementary to each other whereby a form-fitting connection between the covering parts can be realized in Figure 2.

Palsson teaches at least two parallel forming-retaining covering parts which are mutually connected along adjacent side edges and which a backing side directed toward the ground surface and visual side remote therefrom, wherein the two side edges take a step-like form with an inner and an outer edge segment such that the first covering part has a protruding backing side and the second covering part has an overhanging visual side in Figure 10.

Palsson teaches covering parts are provided with co-acting coupling elements placed along side edges wherein the coupling element of the first covering part is a groove (13) which is formed in the protruding backing side and at least open to the visual side and the coupling element of the second covering part forms a tongue (11) extending from the overhanging visual side at least to the ground surface which groove and tongue each have an at least partly curved profile and wherein the groove

undercuts the inner edge segment of the first covering part and the tongue protrudes beyond the outer edge segment of the second covering part in Figure 10.

Palsson teaches each covering part is constructed from a relatively thick base layer (5) forming the backing side and connected thereto, a top layer (3) forming the visual side and the coupling elements (11, 13) are formed in the base layer in Figure 10 and column 5, lines 11-13.

Palsson does not teach the outer edge segment of the first covering part and inner edge segment of the second covering part define a gap in the mutually connected position of the covering parts. Searer teaches the outer edge segment of the first covering part and inner edge segment of the second covering part define a gap in the mutually connected position of the covering parts in Figure 5. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palsson to include the outer edge segment of the first covering part and inner edge segment of the second covering part define a gap in the mutually connected position of the covering parts as taught by Searer in order to space for cover to expand from the environment conditions and minimize warping.

With respect to claim 2, Palsson discloses the inner edge segment of the first covering part and the outer edge segment of the second covering part run substantially transversely of the visual side of the relevant covering part in Figure 10.

With respect to claim 3, Palsson discloses the at least partly curved profile preferably forms a segment of a circle in Figure 10.

With respect to claim 4, Palsson does not teach a chamfered surface is defined between the visual side and side edge of at least one of the covering parts. Searer teaches a chamfered surface (34) is defined between the visual side and side edge of at least one of the covering parts in Figure 2. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palsson to include a chamfered surface is defined between the visual side and side edge of at least one of the covering parts as taught by Searer in order to minimize interference from the visual side when connecting the covering parts at their side edges.

With respect to claim 5, Palsson discloses each covering part has two parallel step-like side edges, the one of which is embodied with the protruding backing side with groove and the other with the overhanging visual side with tongue in Figure 11.

With respect to claim 6, Palsson discloses each covering part has two mutually parallel end edges which enclose an angle with the side edges and which are provided with secondary coupling elements (23) (24) in Figure 14.

With respect to claim 7, Palsson discloses the two end edges also take a step-like form such that the one covering part has a protruding backing side and the other covering part has an overhanging visual side, the secondary coupling element of the one covering part is a recess formed on the top of the protruding backing side and the secondary coupling element of the other covering part is a protrusion formed under the overhanging visual side in Figure 14 and Figure 6.

With respect to claim 8, Palsson in view of Searer discloses the claimed invention except for top layer is formed from a high-grade type of wood. It would have

been obvious to one having ordinary skill in the art at the time of the invention was made to make the top layer from a high-grade type of wood in order to provide durability for the decorative layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Palsson in view of Searer discloses the claimed invention except for the top layer having a thickness of at least 1mm, preferably at least 2.5mm and most preferably in the order of 4mm. It would have been an obvious matter of design choice to make the top layer having a thickness between 1mm and 4mm in order to protect the cover from the environment, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level or ordinary skill in the art.

With respect to claim 9, Palsson discloses the undercut of the groove (13) and the part of the tongue (11) protruding beyond the edge each have an at least partly chambered profile in Figure 10.

Palsson teaches the groove and the tongue each form profiles complementary to each other whereby a form-fitting connection between the covering parts can be realized in Figure 2.

Palsson teaches at least two parallel forming-retaining covering parts which are mutually connected along adjacent side edges and which a backing side directed toward the ground surface and visual side remote therefrom, wherein the two side edges take a step-like form with an inner and an outer edge segment such that the first

covering part has a protruding backing side and the second covering part has an overhanging visual side in Figure 11.

Palsson teaches covering parts are provided with co-acting coupling elements placed along side edges wherein the coupling element of the first covering part is a groove (13) which is formed in the protruding backing side and at least open to the visual side and the coupling element of the second covering part forms a tongue (11) extending from the overhanging visual side at least to the ground surface which groove and tongue each have an at least partly curved profile and wherein the groove undercuts the inner edge segment of the first covering part and the tongue protrudes beyond the outer edge segment of the second covering part in Figure 10.

Palsson teaches each covering part is constructed from a relatively thick base layer (5) forming the backing side and connected thereto, a top layer (3) forming the visual side and the coupling elements (11, 13) are formed in the base layer in Figure 10 and column 5, lines 11-13.

Palsson does not teach the outer edge segment of the first covering part and inner edge segment of the second covering part define a gap in the mutually connected position of the covering parts. Searer teaches the outer edge segment of the first covering part and inner edge segment of the second covering part define a gap in the mutually connected position of the covering parts in Figure 5. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palsson to include the outer edge segment of the first covering part and inner edge segment of the second covering part define a gap in the mutually connected



position of the covering parts as taught by Searer in order to space for cover to expand from the environment conditions and minimize warping.

With respect to claim 10, Palsson in view of Searer discloses the claimed invention except for top layer is formed from a high-grade type of wood. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make the top layer from a high-grade type of wood in order to provide durability for the decorative layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Palsson in view of Searer discloses the claimed invention except for the top layer having a thickness of at least 1mm, preferably at least 2.5mm and most preferably in the order of 4mm. It would have been an obvious matter of design choice to make the top layer having a thickness between 1mm and 4mm in order to protect the cover from the environment, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level or ordinary skill in the art.

With respect to claim 11, Palsson teaches a method for mutually connecting at least two covering parts comprising the steps of:

Orienting a side edge of the second covering part for connecting to the first already arranged covering part substantially parallel to a free side edge of the first covering part, moving the second covering part at a distance above the ground surface to the side edge of the first covering part, rotating the second covering part about an

axis parallel to the side edge thereof, placing the tongue of the second covering part at an angle into the groove of the first covering part and with forming of the connection lowering the second covering part onto the ground surface by rotating it in the opposite direction at column 5, lines 25-41 and Figure 1 and Figure 2.

With respect to claim 12, Palsson teaches after connection thereof the second covering part is displaced parallel to the side edge relative to the first covering part at column 5, lines 27-34.

With respect to claim 14, Palsson discloses the undercut of the groove (13) and the part of the tongue (11) protruding beyond the edge each have an at least partly chambered profile in Figure 10.

Palsson teaches at least two parallel forming-retaining covering parts which are mutually connected along adjacent side edges and which a backing side directed toward the ground surface and visual side remote therefrom, wherein the two side edges take a step-like form with an inner and an outer edge segment such that the first covering part has a protruding backing side and the second covering part has an overhanging visual side in Figure 11.

Palsson teaches covering parts are provided with co-acting coupling elements placed along side edges wherein the coupling element of the first covering part is a groove (24) which is formed in the protruding backing side and at least open to the visual side and the coupling element of the second covering part forms a tongue (23) extending from the overhanging visual side at least to the ground surface which groove and tongue each have an at least partly curved profile and wherein the groove

undercuts the inner edge segment of the first covering part and the tongue protrudes beyond the outer edge segment of the second covering part in Figure 14.

With respect to claim 15, Palsson discloses the inner edge segment of the first covering part and the outer edge segment of the second covering part run substantially transversely of the visual side of the relevant covering part in Figure 10.

With respect to claim 16, Palsson teaches the groove and the tongue each form profiles complementary to each other whereby a form-fitting connection between the covering parts can be realized in Figure 2.

With respect to claim 17, Palsson discloses the at least partly curved profile preferably forms a segment of a circle in Figure 10.

With respect to claim 18, Palsson does not teach the other edge segments define a gap in the mutually connected position of the covering parts. Searer teaches the the other edge segments define a gap in the mutually connected position of the covering parts in Figure 5. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palsson to include the other edge segments define a gap in the mutually connected position of the covering parts as taught by Searer in order to space for cover to expand from the environment conditions and minimize warping.

With respect to claim 19, Palsson does not teach a chamfered surface is defined between the visual side and side edge of at least one of the covering parts. Searer teaches a chamfered surface (34) is defined between the visual side and side edge of at least one of the covering parts in Figure 2. It would have been obvious to one having

ordinary skill in the art at the time the invention was made to modify Palsson to include a chamfered surface is defined between the visual side and side edge of at least one of the covering parts as taught by Searer in order to minimize interference from the visual side when connecting the covering parts at their side edges.

With respect to claim 20, Palsson discloses each covering part has two parallel step-like side edges, the one of which is embodied with the protruding backing side with groove and the other with the overhanging visual side with tongue in Figure 11.

With respect to claim 21, Palsson discloses each covering part has two mutually parallel end edges which enclose an angle with the side edges and which are provided with secondary coupling elements (23) (24) in Figure 14.

With respect to claim 22, Palsson discloses the two end edges also take a step-like form such that the one covering part has a protruding backing side and the other covering part has an overhanging visual side, the secondary coupling element of the one covering part is a recess formed on the top of the protruding backing side and the secondary coupling element of the other covering part is a protrusion formed under the overhanging visual side in Figure 14 and Figure 6.

With respect to claim 23, Palsson teaches each covering part is constructed from a relatively thick base layer (5) forming the backing side and connected thereto, a top layer (3) forming the visual side and the coupling elements (23, 24, 11, 13) are formed in the base layer in Figures 10, 11, and 14.

Palsson in view of Searer discloses the claimed invention except for top layer is formed from a high-grade type of wood. It would have been obvious to one having

ordinary skill in the art at the time of the invention was made to make the top layer from a high-grade type of wood in order to provide durability for the decorative layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

With respect to claim 24, Palsson in view of Searer discloses the claimed invention except for the top layer having a thickness of at least 1mm, preferably at least 2.5mm and most preferably in the order of 4mm. It would have been an obvious matter of design choice to make the top layer having a thickness between 1mm and 4mm in order to protect the cover from the environment, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

With respect to claim 25, Palsson discloses the undercut of the groove (13) and the part of the tongue (11) protruding beyond the edge each have an at least partly chambered profile in Figure 10.

Palsson teaches at least two parallel forming-retaining covering parts which are mutually connected along adjacent side edges and which a backing side directed toward the ground surface and visual side remote therefrom, wherein the two side edges take a step-like form with an inner and an outer edge segment such that the first covering part has a protruding backing side and the second covering part has an overhanging visual side in Figure 10.

Palsson teaches covering parts are provided with co-acting coupling elements placed along side edges wherein the coupling element of the first covering part is a groove (13) which is formed in the protruding backing side and at least open to the visual side and the coupling element of the second covering part forms a tongue (11) extending from the overhanging visual side at least to the ground surface which groove and tongue each have an at least partly curved profile and wherein the groove undercuts the inner edge segment of the first covering part and the tongue protrudes beyond the outer edge segment of the second covering part in Figure 10.

With respect to claim 26, Palsson teaches at least two parallel forming-retaining covering parts which are mutually connected along adjacent side edges and which a backing side directed toward the ground surface and visual side remote therefrom, wherein the two side edges take a step-like form with an inner and an outer edge segment such that the first covering part has a protruding backing side and the second covering part has an overhanging visual side in Figure 10.

Palsson teaches covering parts are provided with co-acting coupling elements placed along side edges wherein the coupling element of the first covering part is a groove (13) which is formed in the protruding backing side and at least open to the visual side and the coupling element of the second covering part forms a tongue (11) extending from the overhanging visual side at least to the ground surface which groove and tongue each have an at least partly curved profile and wherein the groove undercuts the inner edge segment of the first covering part and the tongue protrudes beyond the outer edge segment of the second covering part in Figure 10.

Palsson does not teach the outer edge segment of the first covering part and inner edge segment of the second covering part define a gap in the mutually connected position of the covering parts. Searer teaches the outer edge segment of the first covering part and inner edge segment of the second covering part define a gap in the mutually connected position of the covering parts in Figure 5. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palsson to include the outer edge segment of the first covering part and inner edge segment of the second covering part define a gap in the mutually connected position of the covering parts as taught by Searer in order to space for cover to expand from the environment conditions and minimize warping.

With respect to claim 27, Palsson teaches at least two parallel forming-retaining covering parts which are mutually connected along adjacent side edges and which a backing side directed toward the ground surface and visual side remote therefrom, wherein the two side edges take a step-like form with an inner and an outer edge segment such that the first covering part has a protruding backing side and the second covering part has an overhanging visual side in Figure 11.

Palsson teaches covering parts are provided with co-acting coupling elements placed along side edges wherein the coupling element of the first covering part is a groove (24) which is formed in the protruding backing side and at least open to the visual side and the coupling element of the second covering part forms a tongue (23) extending from the overhanging visual side at least to the ground surface which groove and tongue each have an at least partly curved profile and wherein the groove

undercuts the inner edge segment of the first covering part and the tongue protrudes beyond the outer edge segment of the second covering part in Figure 14.

Palsson teaches each covering part is constructed from a relatively thick base layer (5) forming the backing side and connected thereto, a top layer (3) forming the visual side and the coupling elements (23, 24, 11, 13) are formed in the base layer in Figures 10, 11, and 14.

Palsson in view of Searer discloses the claimed invention except for top layer is formed from a high-grade type of wood. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make the top layer from a high-grade type of wood in order to provide durability for the decorative layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

With respect to claim 28, Palsson in view of Searer discloses the claimed invention except for the top layer having a thickness of at least 1mm, preferably at least 2.5mm and most preferably in the order of 4mm. It would have been an obvious matter of design choice to make the top layer having a thickness between 1mm and 4mm in order to protect the cover from the environment, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level or ordinary skill in the art.



5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palsson et al. (U.S. Patent # 7,121,058) in view of Searer (U.S. Patent # 5,570,554) as applied to claim 11 above, and further in view of Schulte (U.S. Patent # 6,672,030).

With respect to claim 13, Palsson in view of Searer does not teach after the first and second covering parts have been mutually connected a third covering part is arranged in line with the second covering part which third covering part is attached by connecting a side edge thereof to the first covering part and an end edge thereof to the second covering part. Schulte teaches after the first (1b) and second covering (1c) parts have been mutually connected a third covering part (1d) is arranged in line with the second covering part which third covering part is attached by connecting a side edge thereof to the first covering part and an end edge thereof to the second covering part in Figure 5. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palsson in view of Searer to include after the first and second covering parts have been mutually connected a third covering part is arranged in line with the second covering part which third covering part is attached by connecting a side edge thereof to the first covering part and an end edge thereof to the second covering part as taught by Schulte in order to cover the entire area of a floor.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See 892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER J. DARNER whose telephone number is (571)270-3658. The examiner can normally be reached on Monday thru Friday 7:30AM to 4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Darner/  
Examiner, Art Unit 3633

/Brian E. Glessner/  
Supervisory Patent Examiner, Art Unit 3633